

REMARKS

The Applicant hereby traverses the rejection of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 1-21 are pending in this application.

Rejection Under 35 U.S.C. 102(e)

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,396,598 to Kashiwagi et al (hereinafter "Kashiwagi").

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *see* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." *see* M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *see* M.P.E.P. § 2131; citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Claim 1 recites a user data entry device for enabling a user to modify said generated image file. In the Current Action, the Examiner points to Kashiwagi, at numeral 72 of figure 4, to satisfy this limitation. (Current Action, pg. 3). However, the description of Figure 4 makes clear that Kashiwagi does not satisfy this limitation. Rather, Kashiwagi only discloses that a user may "manually input a character or graphic figure to a display unit." (*see* Kashiwagi Fig. 4; col. 10, lines 49-53). The Applicant respectfully submits that inputting a character to a display unit is not the same as modifying a generated image file. As shown in Figures 1 and 2 of Kashiwagi, and discussed at column 10, lines 56-60, device 64 is a see-through display device, which allows a handwritten memo to be viewed as if written onto paper document 52. Again, Kashiwagi does not modify a generated image file via a user data entry device. Thus, Kashiwagi does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 1 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 13 recites annotating said selected ones of said captured image data with said received user-entered data. In the Current Action, the Examiner points to Kashiwagi, at col. 11, lines 25-30, to satisfy this limitation. However, at the Examiner's citation Kashiwagi merely describes "a position relation calculation unit for calculating positional relation of a document with respect to an electronic memo processing apparatus. (see Kashiwagi at col. 11, lines 25-28). The Applicant respectfully submits that calculating a position relation is not the same as annotating captured image data. Moreover, as shown in Figures 1, 2, and 11 of Kashiwagi, and discussed at column 13, line 25 to column 14, line 64, the device 64 is operative to calculate a position of the memo, load a stored document, and then merges the memo and the stored document at the display unit, see column 15, line 21. Again, Kashiwagi does not teach annotating said selected ones of said captured image data with said received user-entered data. Thus, Kashiwagi does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 13 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 19 recites means for annotating said displayed selected image data with said superimposed received user-entered data. In the Current Action, the Examiner points to Kashiwagi, at figs 14 and 17, to satisfy this limitation. However, at the Examiner's citation Kashiwagi does not teach this limitation. Instead, Kashiwagi discloses a "link to other document." Also, as shown in Figures 1, 2, and 14 of Kashiwagi, and discussed at column 16, line 58 to column 17, line 53, the flowchart of Figure 14 is operative to create a memo. Kashiwagi does not teach a means for annotating said displayed selected image data with said superimposed received user-entered data. Thus, Kashiwagi does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 19 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 2-12, 14-18, and 20-21 depend from base claims 1, 13, and 19, respectively, and thus inherit all limitations of their respective base claim. Each of claims 2-12, 14-18, and 20-21 sets forth features and limitations not recited by Kashiwagi. Thus, the Applicants respectfully assert that for the above reasons claims 2-12, 14-18, and 20-21 are patentable over the 35 U.S.C. § 102 rejection of record.

Conclusion

In view of the above remarks, the Applicant believes the pending application is in condition for allowance. The Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10003837-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail, Airbill No. EV482724239US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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